

## BEST AVAILABLE COPY

Application Serial No. 09/975,381

## REMARKS

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## 1. FINAL REJECTION IS PREMATURE; NEW OFFICE ACTION IS

## 5 REQUIRED

Final rejection in the subject application is premature, per MPEP 706.07(d). Rejections of certain claims fail to address the amendments of July 25, 2006, rendering it unreasonably difficult for Applicant to assess the potential grounds for appeal. Chiefly, the final rejection consistently applied the prior art references to previous amendments, failing to address the current claim language at the time of the office action. Namely, language introduced in the amendment dated July 25, 2006 was not considered, causing some question as to whether all claim limitations have been duly considered. In fact, much of the office action appears to repeat language *verbatim* from a previous office action, ignoring the changed claim language.

For example, page 3, 4<sup>th</sup> paragraph of the office action erroneously addressed "wherein when the request is for a predetermined proximity to a target location, the user may choose a radius for said target location," a feature which had already been added to the claims and previously examined. Along these lines, the office action failed to discuss the new feature "distinguishing online providers from offline providers in said integrated list" at all. Additionally, the same findings were made as to claims 22 and 23.

Moreover, in the "Response to Arguments," even though the Examiner explicitly mentioned the newly-added feature, "distinguishing online providers from offline providers in said integrated list," another feature in the claims, "integrating the at least one online provider with the at least one offline provider to provide an integrated list of providers for the item," was addressed, while the newly-added feature was ignored.

All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). MPEP 2143.03. Moreover, it is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. MPEP 706.02(j).

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In view of the office action's failure to appropriately address the claims, Applicant requests the primary examiner to withdraw the final rejection without delay. MPEP 706.07(d). Further, Applicant requests the primary examiner to provide a new office action with a meaningful discussion of all claim features.

- 5 The request for a new Office Action notwithstanding, Applicant will attempt to respond to the Office Action below.

2. **35 U.S.C § 103**

- To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143.

Claims 1, 3 and 6-25 stand rejected as being unpatentable over Pricescan in view of U.S. patent no. 6,594,666 ("Biswas"). Applicant respectfully disagrees.

- As noted above, the present rejection, both the rejection proper and the "Response to Arguments," appears to be directed to claim elements that have already been examined, while the newly-added claim feature has been ignored.

- It appears however, that the Examiner may be relying on page 4 of Pricescan as teaching or suggesting "distinguishing online providers from offline providers in said integrated list."

- The relevant teaching from Pricescan is a Q&A segment answering the question "Does a vendor need to have a web site to be included in the shopping guide?" The answer relates that product and pricing information is gathered on a daily basis and entered into a searchable database, which is updated daily. While the foregoing language may imply that both online and exclusively brick-and mortar retailers are both listed in the shopping guide, there is no teaching that the shopping guide provides any way of distinguishing between online and brick-and mortar retailers.

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Applicant has diligently searched pages 5-12 of Pricescan and can find no teaching to suggest that Pricescan distinguishes online retailers from brick-and-mortar retailers. Biswas, describing a location-aware application development framework, adds nothing to Pricescan. Accordingly, the

- 5 combination of Pricescan and Biswas fails to teach or suggest:

"A computer-implemented method for providing an integrated electronic list of providers, comprising the steps of:

determining at least one online provider for an item;

determining at least one offline provider for the item;

- 10 wherein the determining steps follow a request for a product;

wherein when the request is for a desired geographical area, a user may choose one of several target locations, which have been previously created and stored;

- 15 wherein when the request is for a predetermined proximity to a target location, the user may choose a radius for said target location; and

integrating the at least one online provider with the at least one offline provider to provide an integrated list of providers for the item; and

distinguishing online providers from offline providers in said integrated list."

- 20 Therefore, the combination fails to teach or suggest all elements of the claimed invention.

Even if the combination did teach all elements of the claimed invention, the Examiner must demonstrate a motivation to combine the reference teachings to derive the claimed invention. The motivation must come from the  
25 prior art. A conclusion by the Examiner, as here, that the invention would be obvious to the ordinarily-skilled practitioner, without more, is insufficient to demonstrate the motivation to combine the reference teachings. Thus, on this ground alone, the present rejection is improper.

- 30 There must also be a reasonable expectation of success from the combination. Here, because the combination fails to teach or suggest all elements of the claimed invention, there would be no reasonable expectation of success from the combination.

The Examiner has therefore failed to establish a *prima facie* case of obviousness.

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The foregoing remarks apply equally to claims 22 and 23.

In view of their dependence from allowable parent claims, the dependent claims are deemed allowable without any separate consideration of their merits.

5 For the record, Applicant respectfully traverses any and all factual assertions in the file that are not supported by documentary evidence. Such include assertions based on findings of inherency, assertions based on official notice, and any other assertions of what is well known or commonly known in the prior art.

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**CONCLUSION**

In view of the foregoing, Applicant seeks favorable reconsideration and allowance of all claims in the application. Should the Examiner find it helpful, he is encouraged to contact applicant's attorney at 650-474-8400.

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Respectfully submitted,

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